



17 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

8

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Karin H. Butchko
Carlson, Gaskey, & Olds, P.C.
400 West Maple Road, Suite 350
Birmingham, Michigan 48009

In re Application of
GRIMM et al.
U.S. Application No.: 10/089,032
PCT No.: PCT/EP00/09528
Int. Filing Date: 28 September 2000
Priority Date: 28 September 1999
Attorney Docket No.: 60130-1370
For: VEHICLE DOOR

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 19 February 2003 to accept the application without the signature of joint-inventor, Gregory Keyes.

BACKGROUND

On 28 September 2000, applicants filed international application no. PCT/EP00/09528 which claimed a priority date of 28 September 1999 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 28 March 2002.

On 26 March 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); preliminary amendment; and an information disclosure statement.

On 20 June 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 26 August 2002, applicants filed a Petition under 37 CFR 1.47(a) and the requisite fee and a declaration and power of attorney signed by ten of the eleven joint inventors. The petition under 37 CFR 1.47(a) was dismissed without prejudice in a Decision dated 12 December 2002.

On 19 February 2003, applicants filed "Renewed Petition under Rule 37 CFR 1.47(a)."

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (3) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Petitioner has provided sufficient information that a bona fide attempt was made present a copy of the application papers to the nonsigning inventor, however, the petition and accompanying papers does not provide proof that the nonsigning inventor has refused to join the present application. Horst Schumacher declares that "[w]e sent correspondence to Mr. Keyes by registered mail at his last known address on August 16, 2002 . . . The registered letter was delivered on August 24, 2002 and appears to be signed by Mr. Keyes" and has provided a copy of the letter mailed 24 August 2002 (Exhibit E) and a delivery certificate (Exhibit F) to Mr. Keyes. However, the delivery certificate has not been translated into English. Applicant's must provide a complete translation of the delivery certificate. Additionally, has any other attempts been made to reach the nonsigning

inventor since the initial filing under 37 CFR 1.47(a)?

As to Item (4), applicant states in the present petition that "a complete copy of the declaration was presented to each inventor, and the entire inventive entity appeared in the declaration as signed by the inventors." However, as stated in the previous decision, the declaration filed on 26 August 2002 is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes multiple duplicate sheets. It is unclear if the inventors were presented with only their signature page, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 26 August 2002, which is improper. (See MPEP 201.03, Page 200-7) Therefore, in order to satisfy this item, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Gregory Keyes under 37 CFR 1.47(a) at this time.

CONCLUSION

The renewed petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Anthony Smith
Attorney-Advisor
PCT Legal Office
Tel.: 703-308-6314
Fax: 703-308-6459